IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

[11993/1]

Applicants	:	Huei-Tarng LIOU et al.
Serial No.	:	09/782,072
Filed	:	February 12, 2001
For	:	METHOD OF GILDING QUARTZ OR HIGH ALUMINUM-OXIDE-CONTAINING TUBE DURABLE UNDER HIGH TEMPERATURE AND HIGH VOLTAGE, AND GILDED QUARTZ OR HIGH ALUMINUM-OXIDE-CONTAINING TUBE APPLIED IN OZONE GENERATOR
Art Unit	:	1762
Examiner	:	Michael Cleveland

#6 Fred 8/14/02

Assistant Commissioner for Patents
Washington, DC 20231

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Atty's Reg. #

Atty's Signature

KENYON & KENYON

SIR:

RESPONSE TO RESTRICTION REQUIREMENT

In response to the restriction requirement mailed on June 21, 2002 in the above-captioned application, Applicants provisionally elect with traverse the invention of Group I, i.e., claims 1 to 5. Examination of both groups concurrently is requested, given the commonality of subject matter between the two groups.

The Manual of Patent Examining Procedure (M.P.E.P.) recites the requirements for a proper restriction requirement. In particular, the M.P.E.P. states:

> There are two criteria for a proper requirement for restriction between patentably distinct inventions:
>
> (A) The inventions must be independent (see MPEP Section 802.01, Section 806.04, Section 808.01) or distinct as claimed (see MPEP Section 806.05 - Section 806.05(i)); and
>
> (B) There must be a serious burden on the examiner if restriction is required (see MPEP Section 803.02, Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02).

(M.P.E.P. § 803 (emphasis added)). The fact that both criteria must be satisfied is made all the more clear by the following statement in the M.P.E.P.:

> If the search and examination of an entire application can be made without serious burden, the examiner must examine it on

the merits, even though it includes claims to independent or distinct inventions.

(M.P.E.P. § 803 (emphasis added)). Thus, if the subject matter of the pending claims is such that there would be no serious burden on the examiner to search and examine all of the pending claims at the same time, the examiner is to do so, even if the pending claims are drawn to independent or distinct inventions.

In support of the requirement, the Office Action merely alleges that the inventions of Groups I and II are distinct from each other. However, restriction under 35 U.S.C. § 121 can be made only if two inventions are both independent and distinct. "Independent," as defined in the MPEP (for purposes of restriction practice) means that "there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect." M.P.E.P. § 802.01. It is respectfully submitted that the inventions of Groups I and II are not independent because claim 6 is drawn to a gilded quartz or high aluminum-oxide-containing tube formed in accordance with the method of claim 1, and claims 7 and 8 are drawn to a gilded quartz or high aluminum-oxide-containing tube formed in accordance with the method of claim 5.

In addition, examination of the claims of Group II (claims 6 to 8) would involve searching all of the Patent and Trademark Office classes and subclasses in which the claims of Group I (claims 1 to 5) are also classified. Therefore, the same patentability search would embrace both the gilded quartz or high aluminum-oxide-containing tube and the method of gilding the quartz or high aluminum-oxide-containing tube. Actually, the claims bear such relation to one another as to bring them within the bounds of a single invention.

Moreover, the Office Action states that "the product as claimed may be made by another and materially different process, such retrieving [sic] the coated tube before the cooling stove is below 100°C, for example, at 200°C." Office Action at p. 2. Applicants respectfully disagree. As an initial matter, claim 6 recites "[a] gilded quartz or high aluminum-oxide-containing tube used in ozone generator comprises a gold film formed through the method according to Claim 1," and claim 7 recites "[a] gilded quartz or high aluminum-oxide-containing tube used in ozone generator comprises a gold film formed through the method according to Claim 5" (emphasis added). Accordingly, since claims 6 and 7 make reference to claims 1

and 5, respectively, to define the limitations of the method, which includes the step of "retrieving the tube after the temperature in the stop is below 110°C," the gilded quartz or high aluminum-oxide-containing tube according to claims 6 and 7 cannot "be made by another and materially different process" from the process recited in claims 1 and 5.

In addition, it is respectfully submitted that the unsupported assertions contained in the Office Action that "the product as claimed may be made by another and materially different process, such retrieving [sic] the coated tube before the cooling stove is below 100°C, for example, at 200°C" are without merit. Indeed, it is respectfully submitted that the coated tube recited in claims 6 to 8, which is formed according to a method that includes the step of "retrieving the tube after the temperature in the stop is below 110°C," would have better endurance in use than one retrieved before the stove is below the temperature of 110°C. The coating may better adhere to the surface of the tube in the condition that the tube is retrieved from the stove at a lower temperature.

In view of the foregoing, withdrawal of the restriction requirement is respectfully requested.

Respectfully submitted,

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Dated: 7/22/02

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